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EXAMINER

POND, ROBERT M

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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/821,040	Applicant(s) SONDEREGGER ET AL.	
	Examiner Robert M. Pond	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/07/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,21,22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9,21,22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicants amended claims 1-4, 6-9, 21, 22, and newly added claims 24-28. Claim 5, 10-20 and 23 were canceled. All pending claims 1-4, 6-9, 21, 22 and 24-28 were examined in this final office action necessitated by amendment.

Response to Arguments

Applicant's arguments, see Remarks, filed 07 November 2007, with respect to the rejection(s) of claim(s) 1-4, 6-9, 21, 22 and 24-28 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Flitcroft and Flitcroft, Zucker and Livesay as necessitated by amendment. Brody was withdrawn rendering all arguments moot.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Applicants are claiming a system defined merely by software or terms synonymous with software or files such as "modules" or "interface." Examination was based on the assumption that structural specificity employing computer(s), input/output apparatus, computer-readable medium, as supported explicitly, implicitly or inherently by the instant specification, is in play. Correction is required to overcome the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.**

The omitted elements are: computing apparatus necessary to provide structural specificity to system claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1, 2, 6, 7 and 25 are rejected under 35 USC 102(b) as being anticipated by Flitcroft (WO 99/49424).

Flitcroft teaches all the limitations of claims 1, 2, 6, 7 and 25. For example, Flitcroft discloses a system and methods of issuing single-use or limited-use credit card numbers assigned to a card holder's master credit card number without revealing the master credit card number. See at least abstract; Figs. 1-15; page 5, line 29-page 6, line 11. Flitcroft further discloses:

- Regarding claim 1. displaying an anonymous shopping toolbar in a browser, the anonymous shopping toolbar associated with a credit card issuer and providing a user with an anonymous credit card option for the user to anonymously initiate an on-line transaction; software activated by an icon integrated into an Internet browser that provides a simple interface with a graphical appearance that exploits familiar images of credit cards. Card holder uses the software to conduct electronic commerce transactions. See at least page 29, line 1-page 30, line 32; page 33, lines 12-17. Option to use. See at least page 18, lines 14-23. Please note: sufficient teachings to address "toolbar."
- Regarding claim 1. communicating, to the credit card issuer, a request for an anonymous credit card, the request communicated in response to the user selecting the anonymous credit card option; credit card provider can

post anonymous credit card number(s) on request. See at least page 26, lines 26-28.

- Regarding claim 1. and receiving the anonymous credit card from the credit card issuer, the anonymous credit card having an anonymous transaction number that functions as a credit card number and an expiration date based on a month and a year in which the on-line transaction occurs, whereby the credit card issuer can issue about one trillion unique anonymous transaction numbers per month, wherein the user can anonymously initiate the on-line transaction using the anonymous credit card, and wherein the credit card issuer links the anonymous transaction number to the user's real credit card account;

credit card format; over 1.2 trillion possible unique codes available. See at least page 23, line 4-page 24, line 8. Please note: regarding "about" used above, Flitcroft discloses a range over one trillion. Sufficient to address the claimed subject matter.

- Regarding claim 2. the anonymous credit card available for a single use and having a purchase limit based on an amount of the online transaction.

See at least page 7, lines 1-11; page 14, lines 1-9.

- Regarding system claims 6 and 7. Rejections of claims 6 and 7 are based on the same rationale as noted above.

- Regarding claim 25: first four digits id the credit card company. 4-6 digits define issuing company. See at least page 19, lines 15-25; page 23 line 4- page 24, line 8.

4. Claims 3, 4, 8, 9, 21, 22, 24, 27 and 28 are rejected under 35 USC 103(a) as being unpatentable over Flitcroft (US 6,636,833) in view of Zucker (WO 99/66428) further in view of Livesay (US 7,203,315).

- Regarding claim 3. Flitcroft teaches all the above as noted under the 102(e) rejection and further teaches i) creating an anonymous master credit card by issuing one or more single-use or limited-use credit card numbers to a requesting card holder, ii) using the single-use or limited use card number(s) for online purchase transactions with merchants and iii) security risks associated with a card holder revealing name, master credit card number, expiration date and address. Although Flitcroft does not mention substitutes for the user's real name, Zucker on the other hand in combination with Flitcroft teach and suggest the claimed invention and problems associated with credit card and identity security risks when purchasing products online. Zucker teaches a system and methods of providing privacy through anonymity by providing a registered buyer a pseudo identity (i.e. substitute name) that can be used to browse, register, purchase, make payment and take delivery of products and services. See at least Fig. 1; Fig. 13; pages 2 and 8-11. Therefore it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify Flitcroft to issue a substitute name as taught by Zucker, because the design incentives or market forces provided a reason to make an adaptation, and the invention resulted from application of the prior knowledge in a predictable manner. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

- Regarding claim 21. displaying an anonymous shopping toolbar in a browser, the anonymous shopping toolbar providing a user with an anonymous credit card option for the user to anonymously initiate an on-line transaction; software activated by an icon integrated into an Internet browser that provides a simple interface with a graphical appearance that exploits familiar images of credit cards. Card holder uses the software to conduct electronic commerce transactions. Flitcroft: See at least page 29, line 1-page 30, line 32; page 33, lines 12-17. Option to use. See at least page 18, lines 14-23. Please note: sufficient teachings to address “toolbar.” Flitcroft and Zucker teach all the above as noted under the 103(a) rejection and further teach and suggest requesting a single-use or limited use card number(s) in lieu of revealing a master credit card number as an option to the card holder. Although Flitcroft does not mention an anonymous delivery option, Zucker on the other hand teaches i) a buyer taking delivery of products and services using a pseudo identity not revealed to the seller and ii) the buyer registering privacy preferences on an

opt-in basis. Please note: buyer is communicating a privacy preference. For example, a buyer can receive a pseudo payment identity (pseudo number, name, expiration date) or a pseudo identity but not use it for shopping. See Fig. 13 (Preferences: "Privacy Opt-in for all lists"); pages 10-11. Zucker further teaches after the seller has processed the buyer's order based on use of a pseudo payment identity, a registered freight company picks up the package and delivers the package to the actual name and address of the buyer. Zucker further teaches freight as an option. See at least pages 14-15. Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify Flitcroft to implement buyer communication request for anonymous delivery as an option as taught by Zucker, because the design incentives or market forces provided a reason to make an adaptation, and the invention resulted from application of the prior knowledge in a predictable manner. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

- Regarding claim 21. communicating, to a credit card issuer, a request for an anonymous credit card, the request for the anonymous credit card communicated in response to the user selecting the anonymous credit card option; credit card provider can post anonymous credit card number(s) on request. Flitcroft: see at least page 26, lines 26-28;

- Regarding claim 21. communicating, to a delivery service, a request for an anonymous delivery address, the request for the anonymous delivery address communicated in response to the user selecting the anonymous delivery option; see rationale as noted above for Flitcroft in view of Zucker.
- Regarding claim 21. receiving the anonymous credit card from the credit card issuer, the anonymous credit card having an anonymous transaction number that functions as a credit card number, an expiration date based on a month and a year in which the on-line transaction occurs, an alias that substitutes for the user's real name, and a purchase limit based on an amount of the on-line transaction, whereby the credit card issuer can issue about one trillion unique anonymous transaction numbers per month, wherein the user can anonymously initiate the on-line transaction using the anonymous credit card, and wherein the credit card issuer links the anonymous transaction number to the user's real credit card account;
credit card format; over 1.2 trillion possible unique codes available.
Flitcroft: see at least page 23, line 4-page 24, line 8..
- Regarding claim 21. Flitcroft and Zucker teach all the above as noted under the 103(a) rejection and teach and suggest i) a pseudo delivery address, ii) a delivery service being selected to pickup and deliver purchased items to an anonymous buyer (see at least pages 13-15) and iii) sending the seller an encrypted delivery address of the buyer. When

the sale is completed, the seller schedules the delivery by passing the sales reference number and encrypted delivery address (i.e. embedded delivery address) to the freight company server. The package is picked up by the freight company who decrypts the address and delivers the package to buyer without ever revealing the actual name and address of the buyer to the seller. See at least pages 13-15 and 23-24. Although Flitcroft and Zucker do not mention requesting an anonymous destination address, Livesay on the other hand teaches a system and methods of providing consumer anonymity for online transactions by providing the buyer an alias name, alias shipping address, alias credit card number and alias electronic address. See at least title; abstract; col. 3, lines 35-60. Livesay further teaches for the case of physical goods delivery, the system providing an alias destination address, an address of a third party destination, such that the physical goods purchased by the consumer as part of the transaction are delivered by the merchant (web site operator) to the third party destination address. In this case data from the system correlating a unique identifier on a label of a package (i.e. embedded code) containing the goods with a real name and destination address of the consumer may be utilize to re-label the package while the package is in the custody of a shipping channel (note: hub, center, depot or on-truck), such that the re-labeled package is delivered to the destination address of the user. See at least col. 4, lines 14-32. Therefore it would have been

obvious to one of ordinary skill in the art at time the invention was made to modify Flitcroft and Zucker to use an alias third-party shipping destination and determine using embedded codes that correlate with the buyers real shipping address, the consumers real delivery address as taught by Livesay, because the design incentives or market forces provided a reason to make an adaptation, and the invention resulted from application of the prior knowledge in a predictable manner. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

- Regarding method claim 4. Rejection of claim 4 is based on similar rationale as noted above for claim 21.
- Regarding system claims 8 and 9. Rejections of claims 8 and 9 are based on similar rationale as noted above.
- Regarding claim 22: financial institution and third-party privacy server are integrated. Rejections of claims 8 and 9 are based on similar rationale as noted above. Zucker provides an entity that provides a delivery service-providing pseudo identity services with credit card services. Zucker: see at least page 23.
- Regarding claim 24. Rejection of claim 24 is based on similar rationale as noted above. Flitcroft in view of Zucker teach and suggest communicating the amount of the online transaction to the financial institution (credit card issuer) and buyer pseudo name as noted above.

- Regarding claim 27: anonymous delivery address associated with a hub station. Rejection of claim 27 is based on the same rationale as noted above for the parent claim 4. Also, Livesay teaches the user alternatively picking up the package at the alias destination address. See at least col. 4, lines 14-36.
- Regarding claim 28: real address and billing. Flitrcroft or Zucker or Livesay have user's real address for billing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 2001/0044785 (Stolfo et al.) 22 November 2001; teaches private shipping to anonymous users.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/
Primary Examiner, Art Unit 3625
January 25, 2008